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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/054,728 | 10/25/2001 | Roberto Fagnani | 71726 / 6776 | 3521 |

7590 11/28/2006
Fitch, Even, Tabin & Flannery
Suite 1600
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EXAMINER

TRAN, MY CHAU T

| ART UNIT | PAPER NUMBER |
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1639

DATE MAILED: 11/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/054,728

Applicant(s)

FAGNANI ET AL.

Examiner

MY-CHAU T. TRAN

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 October 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Attached Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: NONE.
Claim(s) objected to: NONE.
Claim(s) rejected: 1-7,9,10,16-18,31-35 and 41-43.
Claim(s) withdrawn from consideration: 8,11-14,36 and 38-40.

AFFIDAVIT OR OTHER EVIDENCE

8. ☒ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Attached Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

ADVISORY ACTION (CONT.)

1. The amendment filed 08/10/2006 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered because:

- a. The proposed claim amendment required further considerations and/or search (e.g. the amendment of claim 3 wherein the phrase "*at least*" is deleted, which narrow the '*molecular weight*' range of the instantly claimed hydrogel, i.e. the '*molecular weight*' range has change to about 5000).
- b. The proposed claim amendments raise the issue of new matter, e.g. the amendment of claim 3 wherein the phrase "*at least*" is deleted, which narrow the '*molecular weight*' range of the instantly claimed hydrogel, i.e. the '*molecular weight*' range has change to about 5000. Moreover, applicant did not provide any indication where such support exists for the new limitation.
- c. The proposed claim amendment may necessitate the modification of outstanding rejection(s) to address the new limitation, e.g. the amendment of claim 3 wherein the phrase "*at least*" is deleted, which narrow the '*molecular weight*' range of the instantly claimed hydrogel, i.e. the '*molecular weight*' range has change to about 5000.
- d. The proposed claim amendment may necessitate the raising of new prior art rejections and/or 112 issues.
- e. There is no convincing showing under 37 CFR 1.116(b) why the proposed claim amendment was not earlier presented.

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f. Applicant arguments are moot in view of the non-entry of the proposed claim amendment. However, the following points are addressed for completeness.

g. With regard to the prior arts of record, applicants' arguments were considered but they are not persuasive for the following reasons.

[1] Applicant contends that the reference of Sundberg et al. does not disclose a '*three dimensional*' array.

[2] Applicant alleges that the reference of Braatz et al. "*is concerned with providing a medical or laboratory device which is resistant to nonspecific protein absorption*" and provides "*a Declaration from one having ordinary skill in this art, who has worked in the field of microarrays for some six year, and who attests to the fact that the meaning of the term "nonspecific protein absorption" is well-known in the art as referring to the adherence of any and all proteins to the surface of a microarray substrate*". Thus, the reference of Braatz et al. teaches away from the claimed invention.

[3] Applicant argues that the reference of Wagner et al. does not disclose a '*three dimensional*' array.

This is not found persuasive for the following reasons:

[1] The examiner respectfully disagrees. It is the examiner's position that the reference of Sundberg et al. does disclose a '*three dimensional*' array.

Sundberg et al. disclose that the substrate of the array include such structure as tubing, spheres, containers, capillaries, plates, and slides (see col. 11, lines 20-24). These structures are '*three dimensional*', i.e. they have the dimensions of

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length, width, and height, and as a result imply that the array of Sundberg et al. is '*three dimensional*'. Hence, the reference of Sundberg et al. does disclose a '*three dimensional*' array.

- [2] The examiner respectfully disagrees. It is the examiner's position that the reference of Braatz et al. does teach away from the claimed invention. Braatz et al. disclosure that the device is "*resistant to nonspecific protein absorption*" implies that *specific* protein absorption can occur. In addition, the term 'resistance' implies that some of the protein will be absorbed. Furthermore, the 1.132 declaration is insufficient to overcome the reference of Braatz et al. because [a] the declaration is defective since it did not include oath under Section 1001 of Title 18 of the United States Code, i.e. the statement of "*I declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon*"; and [b] applicant has misinterpreted the declaration since the declaration refers to proteins that are responsible for background noise, i.e. see paragraph 4 of declaration, which states "*which proteins are then responsible for background noise when a microarray is imaged*". Therefore, the reference of Braatz et al. does not teach away from the claimed invention,

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and the 1.132 declaration is insufficient to overcome the reference of Braatz et al.

[3] The examiner respectfully disagrees. It is the examiner's position that the reference of Wagner et al. does disclose a '*three dimensional*' array. Figure 1 of Wagner et al. illustrate the top view of the array and figure 2 illustrate the cross section of the patch of the array of figure 1 (see col. 9, line 65 thru col. 10, line 4). These illustrations imply that the array of Wagner et al. is '*three dimensional*'. Consequently, the reference of Wagner et al. does disclose a '*three dimensional*' array.

Furthermore, although neither Sundberg et al. nor Wagner et al. disclose limitation that the claimed hydrogel is '*at least 20 μm thick*' this limitation is taught by Braatz et al., and as a result the combine teachings of Sundberg et al. and Braatz et al., and the combine teachings of Wagner et al. and Braatz et al. do render the apparatus of the instant claims *prima facie* obvious. Therefore, the rejections of record are maintained.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to My-Chau T. Tran whose telephone number is 571-272-0810. The examiner can normally be reached on Monday: 8:00-2:30; Tuesday-Thursday: 7:30-5:00; Friday: 8:00-3:30.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Douglas (Doug) Schultz, can be reached on 571-272-0763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mct

November 17, 2006


JAMES SCHULTZ, PH.D.
PRIMARY EXAMINER